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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,276	05/09/2002	Gavin Randall Tame	P-6396	9013

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## PATENT GROUP

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/030,276

Applicant(s)

TAME, GAVIN RANDALL

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 3, 6, and 16 have been amended in response to the previous office action. Claims 1-18 have been examined.

#### ***Claim Objections***

2. Claim 16 is objected to because of the following informalities: Though the claim has been amended, it is listed as "Original." Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8 and 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the phrase "or other machine readable indicium" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "or other machine readable indicium"), thereby rendering the scope of the claim unascertainable.

Regarding claim 10, the phrase "or other biometric data" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "or other biometric data"), thereby rendering the scope of the claim unascertainable.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 7-11, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,157,726 to Merkle et al. in view of U.S. Patent No. 5,671,282 to Wolff et al.

Regarding claims 1 and 16, Merkle discloses a system for authenticating a document wherein the system is available to a user having a smart card establishing the user's identity (see column 4, lines 47-59), and data identifying the user is read from the smart card (see column 4, lines 52-62). Document data is generated from an inputted document (digitization) (see column 4, lines 24-46). A signature (verification data) is generated using the digitized document and user information (see column 4, lines 40-46). The digital signature is affixed to the outputted document (see column 4, lines 63-

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66). Since the printed signed document is then read by another receiving machine, it must be machine-readable (see column 6, lines 52-58).

Merkle does not disclose also recording of authentication data that corresponds to the verification data.

Wolff discloses a system wherein a document is create based upon inputted data for the document along with a identifier for the author, and data for verification is written to the document in machine-readable form. An electronic copy (authentication data) is saved on a server subsystem (see column 7, lines 24-29), so that the data may be later used to verify the document (see abstract and column 7, lines 11-20).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Merkle by saving an electronic copy of the signature on the document, as disclosed by Wolff, so that the data may be later used to verify the document.

As per claims 7, 8, 17, and 18, the document is then read by a client subsystem and retrieves the corresponding information from the server (the document verification database, see column 3, line 65 to column 4, line 4) and compares it with the information on the document (see Wolff, column 7, lines 33-43) to authenticate it.

Regarding claim 9, Merkle discloses visible printed indicia (see column 4, line 68), which are optically readable.

Regarding claims 10 and 11, the verification data may be generated using the operator's cryptographic digital signing key, yielding the operator's digital signature (see column 4, line 46).

5. Claims 2-6 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,157,726 to Merkle et al. in view of U.S. Patent No. 5,671,282 to Wolff et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,341,428 to Schatz.

Regarding claims 2-6, 12, and 15 Though Merkle discloses the use of smart cards containing user data for entering the system, Merkle does not specifically suggest the comparison of the user identification record with user data.

Schatz discloses the storing of a PIN or biometric data such as a fingerprint (see column 3, line 40) within a smart card being used for authentication that must be matched to inputted data at the time of use (see column 3, lines 30-45 and column 4, lines 20-33), and suggests that this leads to a more fool-proof verification system (see column 2, lines 3-22).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Merkle by using biometric data from a smart card at the time of use, as disclosed by Schatz, as this leads to a more fool-proof verification system.

Regarding claim 13, over and above Merkle's use of encryption, as described above, the modification of Wolff includes the encryption of the verification data and later decryption to complete the process (see Wolff, column 8, lines 11-49).

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Regarding claim 14, the database is central with respect to an author of documents; communications facilities enable on-line retrieval (see column 3, line 65 to column 4, line 7).

### ***Response to Arguments***

6. Applicant's arguments, see Remarks, filed 30 May 2006, with respect to the rejections of claims 1 and 16 under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are made in view of the art cited above.

### ***Conclusion***

7. Due to the new grounds of rejection presented herein, this action is non-final.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached at (571) 272-3799.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450

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Alexandria, VA 22313-1450  
**Or faxed to:**  
(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH *MEH*

November 14, 2006

*Gilberto Barron Jr*  
GILBERTO BARRON JR  
SUPERVISORY PATENT EXAMINER  
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